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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,601	02/04/2005	Peter Tiesler	ZAHFRI P704US	1433
20210	7590	05/02/2007		
DAVIS & BUJOLD, P.L.L.C. 112 PLEASANT STREET CONCORD, NH 03301			EXAMINER HOLMES, JUSTIN K	
			ART UNIT 3681	PAPER NUMBER
			MAIL DATE 05/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/523,601

Applicant(s)

TIESLER, PETER

Examiner

Justin K. Holmes

Art Unit

3681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33,34,43 and 44 is/are allowed.
- 6) ☒ Claim(s) 23-25,27,29-32,35,37 and 38 is/are rejected.
- 7) ☒ Claim(s) 26,28,36 and 39-42 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The Examiner acknowledges receipt of the Amendment filed on February 16, 2007. Accordingly, claims 23-44 are currently pending.

Claim Objections

2. Claim 26 is objected to because of the following informalities: In line 3 of the claim it is stated that "at list one of" this appears to be a typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The rejection of claims 24, 26 and 34 under second paragraph of 35 U.S.C. 112 as stated in the Office Action dated December 20, 2006 is withdrawn in view of the Amendments to the claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 23-25, 27, 29-32 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,833,566 to Showalter.

The Showalter patent teaches an automatic transmission 14 having a drive shaft 62, a driven shaft 198 on an axis different than the drive shaft 62, one planetary gear 80 coaxial to the drive shaft 62 and having at least one planetary gear set 80 and a switch element 120 for selective transmission of an input rotational speed of the drive shaft 62

Art Unit: 3681

to an output element 110 of the planetary gear and one chain drive 74 of constant ratio abutting in a axial direction on a transmission housing wall 60, and whose drive wheel 70 is connected with the output element 110 of the planetary gear and situated coaxially to the drive wheel 70 and whose driven wheel 174 is operably connected with a driven shaft via a constant ratio, the drive wheel 70 of the chain drive 74 radially overlaps at least partially, in an axial direction, the switch element 120 axially directly abutting on a side thereof remote from the transmission housing 60. See Figs. 2 and 3.

Regarding claim 24, the drive wheel 70 of the chain drive abuts in an axial direction directly on one disc carrier of the switch element. The disc carrier as broadly recited in the claims is defined as the flange 128 that has a disc shape. See Fig. 2.

Regarding claim 25, the one servo device 140 of the switch element 120 abuts on the drive wheel 70 of the chain drive is situated upon a side of the switch element 120 facing the drive wheel 70 of the chain drive. The side of the switch element 120 facing the drive wheel 70 as broadly recited in the claim is defined as being below the lower most part of the flange 128 as shown in Fig. 2, therefore, the servo device 140 is on the side of the switch element 120 facing the drive wheel 70.

Regarding claim 27, the switch element is a sliding clutch with teeth 122 and 124. See Figs. 2 and 3.

Regarding claim 29, the drive wheel 70 and the driven wheel 174 of the chain drive are centered on the same housing element. See Fig. 2.

Art Unit: 3681

Regarding claim 30, the drive wheel 70 is supported on one projection of the housing wall 60, the portion of the housing 60 that is holding oil seal 28 on the outer circumference in place, extending in an axial direction of the chain drive. See Fig. 2.

Regarding claim 31, the drive wheel 70 is supported on one shaft 62 fixedly connected with a transmission housing 60. The shaft 62 is fixedly connected in that the shaft is held in place in the housing 60 and does not slide in an axial direction.

Regarding claim 32, a bearing 68 of the drive wheel is a roller bearing, a radial bearing 68, an axial bearing 76 on the side of the transmission housing wall 60, and an axial bearing 68 on the side of the switch element. See Fig. 3.

Regarding claim 35, the transmission housing wall 60 abutting the chain drive faces one prime mover 12 of the automatic transmission. See Fig. 1.

Accordingly, all the elements of claims 23-25, 27, 29-32 and 35 are anticipated by the Showalter patent.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,833,566 to Showalter in view of U.S. Patent No. 5,215,161 to Kobayashi.

The Showalter patent lacks a teaching of an oil pump of the automatic transmission integrated in a stator shaft.

Art Unit: 3681

The Kobayashi patent teaches an automatic transmission having a stator shaft 32 that is integral with the cover 9 of an oil pump 10. See Fig. 1b.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Showalter patent to include the oil pump as taught in the Kobayashi patent in order to provide a fluid operated clutch. See column 2, lines 33-35 of the Kobayashi patent.

8. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,833,566 to Showalter in view of U.S. Patent No. 3,618,713 to Batchelor.

The Showalter patent lacks a teaching of a lubrication of the chain drive having a spray pipe by which lubricant is sprayed on an inner side of one chain of the chain drive.

The Batchelor patent teaches an apparatus for lubricating an endless chain. A spray pipe 44 having a tube 76, sprays lubricant onto a chain 30. See column 4, lines 16-20. The lubricant is sprayed on an inner side of one chain 30 as shown in Fig. 1.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Showalter patent to include the lubrication system as taught in the Batchelor patent in order to provide an efficient way to lubricate a chain. See column 1, lines 68-70 of the Batchelor patent.

Allowable Subject Matter

9. Claims 33, 34, 43 and 44 are allowed.

10. Claims 26, 28, 36 and 39-42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments filed February 16, 2007 have been fully considered but they are not persuasive. Specifically, the Applicant has argued that all the elements of claim 23 are not taught or suggested by the Showalter `566 patent.

12. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that a claw clutch should be located at least partially inside a space defined and formed by the drive wheel of the first chain drive as stated in the Amendment on page 9 filed on February 16, 2007) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Showalter `566 patent shows the drive wheel 70 of the chain drive 74 radially overlaps at least partially, in an axial direction, the switch element 120. The overlap takes place on the inner circumference of the switch element 120.

13. In response to applicant's argument that that Kobayashi `161 patent does not teach or suggest the elements of claim 37 in that that oil pump is integrated into a stator shaft, it should be noted that the stator shaft 32 is integral with the cover 9 of the oil pump 10. Since the cover 9 forms part of the oil pump 10 the stator shaft 32 is integral with the oil pump 10. See column 3, lines 11-16 of the Kobayashi `161 patent.

14. In response to applicant's argument that the Batchelor `713 patent is nonanalogous art as it relates to the rejection of claim 38, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be

Art Unit: 3681

reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Batchelor '713 patent is used to show the teaching of lubricating a chain with spray pipes. The general teaching of lubricating a chain is well known to those having ordinary skill in the art, therefore, the Batchelor '713 patent is used to show one way of lubricating a chain.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,579,204 to Brown et al. and U.S. Patent No. 7,189,179 to Williams et al. both teach various transmission assemblies and chain transfer drives.

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Facsimile Transmission

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is (571) 273-8300. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on _____ (Date)

Typed or printed name of person signing this certificate:

(Signature)

Art Unit: 3681

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

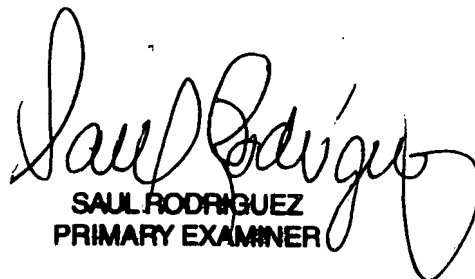
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin K. Holmes whose telephone number is (571) 272-5930. The examiner can normally be reached on 8:00am to 4:30pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (571) 272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3681

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JKH
4/23/07


SAUL RODRIGUEZ
PRIMARY EXAMINER